

REMARKS

Claim 35 stands rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Office Action asserts that the claim is “not enabled for assisting the turning of the input shaft with gas cylinders” because “the input shaft of the instant invention is disclosed as being turned manually.” Office Action, p. 2.

Applicant disagrees with this rejection for at least the reasons set forth on pages 12-13 of the Amendment filed January 22, 2004. However, solely to reduce the outstanding issues in this case, Applicant has amended claim 35 as suggested by the Examiner. Please note that the amendment to claim 35 does not raise any new issues because, as stated in the Office Action, “the examiner treat[ed] the limitation of using the gas cylinder as if it were used to help lift or lower the first section in conjunction with the jackscrews.”

Claims 1, 8-12, 25, 32 and 33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Beach in view of Bressler. Reconsideration is respectfully requested for the following reasons.

This rejection is the same as its previous version, other than that the Office Action adds claim 12 which was previously rejected only under 35 U.S.C. 112. The rejection is traversed for the same reasons presented in Applicant’s Amendment filed with the PTO on January 22, 2004. In this paper, the Applicant primarily addresses the new arguments presented in the “Response to Arguments” portion of the Office Action, on pages 9-11, and the new rejection of claim 12.

Applicant provided a detailed argument that Beach fails to teach a “sliding mechanism comprising a block and a lead screw for moving said block” and a “third section disposed over said sliding mechanism and attached to said block,” as recited in claim 1. Applicant explicitly explained how the elements in Beach, asserted by the Office Action to account for the claimed elements, are not the same as the claimed elements, can not be the same as the claimed elements, and do not function as do the claimed elements.

For example, claim 1 recites a “sliding mechanism comprising a block and a lead screw for moving said block.” The moving sliding block is shown, for example, as element 198 in Figure 7 of the specification. In a preferred embodiment, the block 198 moves linearly in response to rotation of lead screw 196. Specification, page 11, lines 9-15. The Office Action proposes that Beach teaches a “block (111)” which corresponds to the claimed moving block. To the contrary, element 111 of Beach is opposite to the claimed movable block. Element 111 in Beach is nut which is “anchored to an end beam ... of the upper dolly frame.” Column 7, lines 40-43 (emphasis added). Thus, element 111 in Beach has nothing in common with the claimed moving block because it does not move.

Further, claim 1 recites a “third section disposed over said sliding mechanism and attached to said block.” This is an important feature of the claimed invention. The specification discloses, for example, an upper plate 40 which is mounted to the sliding mechanism. Specification, page 11, lines 16-25. Beach fails to teach or suggest this limitation. The Office Action asserts that Beach discloses a sliding mechanism “comprising a block (111) and a lead screw (110),” and a “third section (13) [is] disposed over said sliding mechanism and attached to said block.” There is no basis for this assertion. In Beach, the “third section (13)” is not “disposed over said sliding mechanism” -- it is the sliding mechanism. Elements 111 and 110 in Beach are part of the assembly 13. See column 7, lines 10-50 and Figure 2. The assembly 13 cannot be the claimed “sliding mechanism” and at the same time a “third section disposed over said sliding mechanism.”

These arguments have yet to be addressed by any Office Action, and this rejection is improper for at least this reason. Rather than responding to the arguments restated above, which point out that several specific limitations are neither taught nor suggested by Beach, the Office Action puts on record a broad dismissive statement. The Office Action’s response, in its entirety, is as follows: “The cited reference need not explicitly point out each element of a claim, but merely teach a device with those elements and Beach does so.” Office Action, pp. 9-10. This bare statement, together with the

insufficient rejection itself, fall well short of the requirement set forth in the MPEP that “all the claim limitations must be taught or suggested by the prior art.” MPEP 2143.03.

Moreover, the Office Action admits that Beach does not teach every limitation of claim 1, and relies on Bressler for several shortcomings. For example, claim 1 recites that the sliding mechanism comprises “slider blocks having slide rails.” The Office Action admits that Beach fails to teach or suggest this limitation, and relies on Bressler for this shortcoming. To this end, Applicant set forth in the previous Amendment detailed arguments as to why the elements of the two references are not properly combinable under the statutory requirements as summarized in the MPEP. MPEP §§ 2142, 2143. Amendment of January 22, 2004, pp. 14-16.

For example, Bressler relates to a method of applying a printing medium to a printing roll employed in rotogravure printing. Rotogravure printing is a commercial printing process that controls ink thickness and area of coverage. Bressler discloses a mechanism comprising a platform 22 having guide rails 24. A carriage 32, having supports 30 engaged with the guide rails 24, moves along the platform 22.

According to the Office Action, it would have been obvious “to one of ordinary skill in the art ... to provide the device taught by Beach with the guide rails and blocks taught by Bressler et al. in order to keep the first and second sections in alignment at all times while allowing for linear adjustments as needed.” Office Action, page 4. The proposed combination is a blatant hindsight reconstruction, where the Office Action simply picks and chooses elements from prior art references to come up with the claimed combination. The only motivation for such a combination is the Applicant’s claim itself.

Beach relates to an aircraft component dolly for moving jet engines. The Beach dolly has a mechanism for precise linear adjustments – adjuster assembly 13. The assembly 13 includes two carriages 103 that are connected by telescoping tubular rods 106. Carriages 103 are supported by rollers 104 such that the carriages 103 can move linearly

along tracks 105. Thus, Beach discloses a mechanism suitable for linear movement of jet engines.

Bressler relates to a device used in the printing industry. The device has a carriage with supports which slide on guide rails of a platform. There exists absolutely no motivation to somehow substitute this assembly for the adjuster assembly 13 of Beach. Beach already has an assembly which is suited for the application for of axially moving aircraft engines on a dolly. Such an assembly, as disclosed by Beach, has carriages, connected by telescoping rods, and is supported by rollers that move linearly in tracks. The wild assertion that this assembly may for some reasons be removed, and substituted for with a slide and guide rails imported from the printing industry is nothing more than imagination on behalf of the Office Action.

There exists no motivation for the proposed combination. Beach identifies no problem with its adjuster assembly 13, and Bressler does not propose that its printing industry-mechanism should somehow be used for moving aircraft engines. Thus, no motivation exists in the references themselves for such a combination. And, the Office Action's reliance on the "skill in the art" component for motivation is misplaced because there is no motivation for the proposed combination based on the nature of the problem to be solved or the teachings of the prior art. As explicitly provided in MPEP:

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

MPEP 2143.01. The level of skill in the art component cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999); MPEP 2143.01. The Office Action's bare reliance on the "skill in the art" for motivation is improper.

The Office Action's response to these arguments is as follows: "In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning." Office Action, p. 10.

This is nothing but a form paragraph that ignores each and every reason set forth by the Applicant as to why the references are not properly combinable. For example, the Applicant explained that Beach already has the mechanism which the Office Action attempts to take out of Bressler and substitute into Beach, and that because the references relate to wholly different and unrelated applications, it would not have been prudent, let alone obvious, to make such a substitution. Applicant's arguments are not simply "hindsight reconstruction" arguments, but rather address the complete absence of any motivation to make the purported combination. For the reasons discussed in the January 22, 2004 Amendment, and because the Office Action has no answer to the Applicant's arguments, the proposed combination is improper, and claim 1 is allowable for this additional reason.

Claims 8-12 depend from claim 1 and are allowable for at least the same reasons as claim 1, and for other reasons. Regarding the new rejection of claim 12, the Office Action asserts that "Beach further teaches providing a third section (132) for moving a load in a transverse direction in relation to the first sliding section." Office Action, p. 4. Initially, this rejection is traversed as claim 12 is allowable because it depends from claim 1, which is allowable as discussed above. And, the Office Action's attempt to reject claim 12 does not even account for all the limitations of claim 12.

Claim 12 recites "[t]he apparatus according to claim 1 further comprising a second sliding mechanism over said third section capable of motion in a second horizontal direction perpendicular to said first horizontal direction, and a fourth section disposed over said second sliding mechanism capable of motion in said vertical direction, first horizontal direction and second horizontal direction." To reject the entire claim, the Office Action asserts only that "Beach further teaches providing a third section (132) for moving a load

in a transverse direction in relation to the first sliding section.” Office Action, p. 6. Apparently, the Office Action in the above-quote mistakenly states “third section” as opposed to a “fourth section,” as recited in claim 12. Regardless, the Office Action’s comparison makes no sense.

The carriages 132 of Beach cannot be compared to the claimed “fourth section” because in Beach the carriages 132 are a component of the load carrying assembly 13 (col. 8, ll. 15-16), which the Office Action earlier equated to the claimed “third section.” Office Action, p. 3. But, according to claim 12, the fourth section has a sliding mechanism disposed over the third section, and is thus separated from the third section by the sliding mechanism. Thus, as claimed, the “third” and “fourth” sections are not part of the same assembly, and Beach fails to teach or suggest such a structure. Therefore, the Office Action’s assertions are not correct. Claim 12 is allowable for these additional reasons, and also because the Office Action fails to state how the other limitations of claim 12 are met by the reference.

Claims 2-4, 7, 26-28 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Beach in view of Bressler as applied to claims 1 and 25, and further in view of Mills. This rejection is traversed, as discussed on page 19 of the Amendment filed on January 23, 2004, because it is based upon the improper rejection of independent claims 1 and 25, as discussed above. Claims 2-4, 7, 26-28 and 31 depend from claims 1 and 25, and incorporate all of the limitations of their base claims. These dependent claims are allowable for at least the same reasons as for allowance of their base claims, and for other reasons.

Claims 13, 17, 19, 20-24 and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Beach in view of Mills, and further in view of Nemoto. This rejection is the same as its previous version, other than that the Office Action adds claim 24 which was previously rejected only under 35 U.S.C. 112. This rejection is traversed for the same reasons as Applicants set forth previously on page 3 of the Request for Reconsideration filed on June 12, 2003.

Claim 13 recites “a lifting mechanism disposed between said base frame and said first section for lifting and lowering said first section in a vertical direction with respect to said base frame, said lifting mechanism comprising a jacking screw mechanism and a gas cylinder assembly, said jacking screw mechanism having a manual drive mechanism.” The Office Action admits that Beach fails to teach or suggest a “lifting mechanism being a combination of a manual jack screw and a pneumatic lift device.” For this shortcoming, the Office Action attempts to rely on Mills, but admits that even Mills “do[es] not teach the jackscrew as being manually actuated.” For this shortcoming, the Office Action relies further on Nemoto.

This proposed combination is another example of the Office Action’s gymnastics of combining different references with nothing but the claimed invention as the road map. With such practice, not a single invention comprising innovative combinations of mechanical components would ever be patentable. The Office Action would simply find other references that disclose, separately, the concepts taught by the invention, and proclaim that the invention is obvious. The MPEP and law specifically reject this type of practice.

Initially, Beach and Mills are not properly combinable. The Office Action states that it would not have been obvious to “provide the device taught by Beach with the lift assemblies taught by Mills et al. and to operate then manually as taught by Nemoto in order to allow the apparatus to align the object being lifted with its intended receiver in a manner that minimizes the chance of damage to the object while it is being mounted.” Office Action, page 6. However, no motivation exists for such a combination.

There is no suggestion or motivation in the references themselves to make the proposed combination, and the Office Action does not assert that any exists. Rather, the Office Action apparently relies on knowledge in the art for supplying the required motivation, which is to “minimize[] the chance of damage.” There is simply no support for this assertion because the mechanism of Beach is self sufficient. Beach discloses a hydraulic scissor lift assembly 12 which is described in detail in column 4, line 30 through

column 7, line 10. The scissor lift 12 has main rams 77, booster rams 90, a pump 96 with check valves to control hydraulic flow rates, and a safety means for preventing unwanted or accidental movement of the frame. Column 5, line 37 through column 6, line 69. There are no shortcomings or problems identified in Beach with respect to its lift mechanism, nor did the Office Action point to any knowledge in the art that would suggest any shortcoming. Thus, there is no motivation or reason to add to Beach's lift assembly an extra "series of jack screws" or a "series of pneumatic lifts." Such a "modification" would be unnecessary and impractical in Beach.

The only reason behind the proposed combination is the Applicant's disclosure. The Office Action uses the claimed invention as an instruction manual to pick and choose among features in Beach and Mills, and then relies on "skill in the art" for motivation to propose an unnecessary modification. To avoid this very result the Federal Circuit has stated that "[r]arely ... will the skill in the art component operate to supply missing knowledge of the prior art to reach an obviousness judgment." *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). Thus, the combination proposed by the Office Action is improper, providing added reasons why claims 2-4 and 7 should be allowed.

For at least these reasons, claim 13 is allowable over the asserted combinations. Claims 17 and 19-23 depend from claim 13 and should be allowed for at least the same reasons as claim 13.

The Office Action "responds" to Applicant's arguments by stating that "[t]he hindsight argument is not proper in that applicants states [sic] in paragraph 1 on page 9 of the specification that many variations can be implement [sic] by one of ordinary skill in the art." Office Action, p. 10. This statement is misplaced for several reasons. First, the cited paragraph from the specification discusses only the lift mechanism 60 which has jacking mechanisms 80, and the cited sentence from the specification states only that variations can be implemented "to the lift mechanism 60." This has nothing to do with combining the jacking mechanism with another type of mechanism, such as a pneumatic mechanism, as the Office Action attempts to do with the proposed combination of Beach and Mills.

Moreover, the Applicant's statement that variations could be made to its invention in no way means that somehow prior art could be combined to form the very invention itself. This is a gross misapplication of the Applicant's specification by the Office Action.

The Office Action asserts further that "on paragraph 2 page 10 of the specification the applicant notes the equivalency of jack screws, pneumatic cylinders and hydraulic cylinders. Thus the references are properly combinable as they all teach lift mechanisms using either jack screws pneumatic cylinders or hydraulic cylinders or some combination of the three." Office Action, pp. 10-11. This, again, is a mischaracterization of the Applicant's disclosure. The referred to section of the specification says that "[t]he vertical movement of plate 30 can be accomplished, for example, solely with four gas cylinders disposed in place of the jacking mechanisms 80. Alternatively, hydraulic cylinder assemblies may be used instead of gas cylinder assemblies 50." This statement does not "note[] the equivalency of jack screws, pneumatic cylinders and hydraulic cylinders," as misstated by the Office Action. And, more importantly, this statement is from the Applicant's own disclosure and discusses how the Applicant's invention can be used – it is not something in the prior art or in the references themselves that the Office Action can rely on for motivation. Thus, Beach and Mills are not properly combinable.

Moreover, since this rejection relies on a combination of three references, Applicant also explained why the combination of Nemoto with the (already improper) combination Beach and Mills is improper. The Office Action offers that motivation to combine Nemoto with Beach and Mills is to "allow the apparatus to align the object being lifted with its intended receiver in a manner that minimizes the chance of damage to the object which it is being mounted." Office Action, page 6. This statement is based on nothing in the references. Beach and Mills say nothing about improving their jacking systems to achieve the Office Action's proposal. And, Nemoto, which is directed toward a positioner for semiconductor device testing, is wholly unrelated to Beach and Mills, which relate to aircraft engine positioning devices. Again, the only reason for the proposed

combination is the Applicant's disclosure. See Amendment dated January 22, 2003, p. 17. This argument has yet to be addressed in any Office Action.

Finally, the January 22, 2003 Amendment presented arguments as to why claim 34 is allowable over the asserted combination (even if proper, and it is not) because the references, taken alone or in combination, fail to teach or suggest all of the limitations of claim 34. Claim 34 recites a "lifting and lowering mechanism comprising at least four jacking screws having a manual transmission system for operation of said jacking screws, said lifting and lowering mechanism further comprising at least two gas cylinders having a pressurized gas source for operating said gas cylinders." Further, claim 34 recites that the "said gas cylinders assist said jacking screws in said lifting and lowering mechanism." The cited references, taken alone or in combination, fail to teach or suggest these claim limitations, and the Office Action does not contend to the contrary. This is an additional reason why claim 34 is allowable. This argument, which was raised in the Amendment dated July 14, 2003, has not been addressed by the Examiner.

The Office Action's only "response" with respect to claim 34 is as follows: "The same arguments are presented against the rejection of claim 34 as used against the rejection of claim 34, as such the examiner uphold [sic] that rejection as well for the reasons given above." This statement makes no sense, and fails to address the Applicant's argument that the references fail to teach or suggest every limitation of claim 34.

The new rejection of claim 24 is traversed for the reasons discussed above with respect to claim 12. For all of these reasons, the rejection of claims 13, 17, 19, 20-24 and 34 is improper and should be withdrawn.

Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Beach, Mills and Nemoto as applied to claim 17, and further in view of Bressler. This rejection is traversed for the same reasons discussed above with respect to claims 13 and 17 (from which claim 18 depends). Also, the addition of a fourth reference, Bressler, to the already improper combination of Beach, Mills and Nemoto, is improper.

Claims 35, 39-42, 44 and 45 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Beach in view of Nemoto. This rejection is traversed. Amended claim 35 recites that supplying the pressurized gas to the gas cylinder assemblies is to “assist moving [a] support section.” The cited references, taken alone or in combination, fail to teach or suggest this limitation. Moreover, as discussed above, Beach and Nemoto are not properly combinable. Claims 39 and 40 depend from claim 35 and should be allowed together with claim 35.

Claim 41 has been amended to recite “providing a base frame, a top frame, and a middle frame disposed between said base frame and said top frame; [and] providing a lift mechanism, having jacking mechanisms and gas cylinder assemblies, between said base frame and said middle frame.” As discussed above with respect to claim 35, Beach in view of Nemoto fail to render obvious this claim limitation. For at least these reasons, claim 41 is allowable. Claims 42, 44 and 45 depend from claim 41 and is allowable together with claim 41, and also because the unique combinations recited by these dependent claims are neither taught nor suggested by the cited prior art.

The Office Action’s only response is that “[i]n regards to the rejection of claim 41 again refer to page 9 paragraph one where the applicant teaches one of ordinary skill in the art modifies [sic] the jacking mechanisms as needed for any particular situation.” This bare statement does not address the Applicant’s argument that the references, taken alone or in combination, fail to teach or suggest all of the limitations of claim 41. And, with respect to the combination of the references, the Office Action’s statement is a mischaracterization of the specification and is misplaced, as discussed above. Claims 39 and 40 depend from claim 35, and claims 42 and 45 depend from claim 41. These dependent claims are allowable for at least the same reasons as for allowance of their base claims.

Claim 43 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Beach in view of Nemoto as applied to claim 41, further in view of Shiiba. This rejection is

also traversed. Claim 43 depends from claim 41, and should be allowable for at least the reasons for allowance of its base claim.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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